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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,278	03/25/2004	Naoki Yamane	9683/174	6036

7590 10/11/2006
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
P.O. Box 10395
Chicago, IL 60610

EXAMINER

ADDY, ANTHONY S

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/809,278

Applicant(s)

YAMANE ET AL.

Examiner

Anthony S. Addy

Art Unit

2617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 15-33.
Claim(s) withdrawn from consideration: 9-14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attachment (Response to Arguments).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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Examiner: Anthony S. Addy
Phone: (571) 272-7795

ADVISORY ACTION

Response to Arguments

Applicant's arguments filed 05 September, 2006 have been fully considered but they are not persuasive.

With respect to applicant's argument that, "Neither Johnson nor Chang, either alone or in combination, describe first and second applications executable on a communication terminal to generate email messages, since Chang fails to describe two email applications executable on a communication terminal and Johnson fails to teach or suggest both a first application and a second application executable to open an email application (see page 8, second paragraph and page 9, third & fourth paragraphs of the response)," examiner respectfully disagrees and maintains that Johnson in view of Chang teaches the limitations as claimed. Examiner reiterates that Johnson teaches a mobile information device that includes an email circuit, routine or application 655 enables a user of the mobile information device to **read** and **write** e-mail, and the email circuit, routine or application 655 transmits and receives an e-mail from remote locations via a network interface (see p. 8 [0089 & 0092], p. 9 [0097] and Fig. 14; shows a mobile information device 600 including an email circuit, routine or application 655 [i.e. reads on a first application executable on a communication terminal to generate an email message, to transmit an email message to an email server, to receive an email message from said email server, and to open an email message])). Johnson further teaches a user of the mobile information device accesses an e-mail file via either the e-mail circuit, routine or application 655, or using a document viewer circuit, routine or

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application 660, which enables the user of the mobile information device to view mobile information device-enabled documents, and to read and write a word-processor style document (see p. 8 [0089 & 0092], p. 9 [0097] and Fig. 14; shows a mobile information device 600 including a document viewer circuit, routine or application 660 [i.e. the document viewer circuit, routine or application 660 broadly reads on a second application executable on a communication terminal to generate email messages or to open an email application, since Johnson teaches a user of the mobile information device **accesses an e-mail file** via **either the e-mail circuit, routine or application 655, or using a document viewer circuit, routine or application 660**)). Examiner further reiterates that Chang teaches a plurality of programs for retrieving and opening an email (see col. 1, lines 29-44), which in combination with the teachings of Johnson meets the limitations as claimed.

Furthermore it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the present application, applicant's arguments are based on considering each reference individually while the rejection is based on a combination of references, hence the rejections using the combination of Johnson, Chang, Alfred and Lahti are proper and maintained.